

## REMARKS

Claims 1-38 were pending in the application. Claims 16-20 and 22-38 are withdrawn. Claims 1-15 and 21 have been rejected. Claim 2 and Claims 22 to 35 have been canceled. New claims 39 and 40 have been added. Claims presently active are therefore, claims 1, 3 to 21, and 36 to 40. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

The Examiner's comments together with the cited references have been carefully studied. Favorable reconsideration in view of the foregoing amendments and following remarks is respectfully requested.

Claims 1-15 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morita et al. for reasons of record and for reasons given below. It is the conclusion of the Examiner that Applicants' disclosed method of formation and the method of formation disclosed in Morita et al. cannot be distinguished from one another. On this basis the Examiner states that "the claim limitations that have been added to claim 1, while not specifically disclosed by the reference, are considered to be inherent therein when the range of stretching is as set forth by the reference at page 5, lines 27-30."

This rejection is in clear error and should be withdrawn. The Examiner has failed to give due respect to the Declaration under 37 C.F.R. 1.132, which categorically states that the examples of Morita et al. do not meet the claim limitations of the present invention. Thus, the Declaration establishes that the claim limitations are, in fact, not inherent within the cited reference.

The Examiner has stated that Applicants have the "burden" to "demonstrate that the medium of the prior art will not meet this claim limitation." Applicants, however, find it unnecessary to go to the very considerable time and expense of running extrusion testing of various materials to prove something they already know, especially since the Applicants filed the Application three years ago and is otherwise occupied with other Research and Development at the present time.

Furthermore, the Examiner's rejection is based on clear error in the law. It is elementary in patent law that inherency applies to anticipation,

not to obviousness. Therefore, there is no need for Applicants to establish that the claimed invention is not inherent in various broad ranges in the prior art selected with hindsight based on Applicants' own disclosure. In point of fact, Morita et al. disclose 14 actual examples and not one of them is remotely near Applicants' invention and would not produce a material having the required properties for an inkjet recording element as explained in detail in Applicants' prior response.

One may speculate as to why Morita et al. failed to obtain the open-celled film of the present application: Perhaps because they were not able to (formulation difficulties, tearing, and other problems have been referred to). Perhaps because they did not want a material as presently claimed, since they desired a leakproof material. Perhaps because they did not know it was possible to simultaneously obtain such high biaxially stretching and high loadings (this is suggested by Comparative Example 2 in which simultaneously high loading and stretching resulted in "extrusion impossible"). However, obvious to try is not the test of patentability. Nor is obvious to try based on Applicants' disclosed invention the test of patentability. Biaxially stretching at high loadings is nowhere taught by Morita et al. Nor is the use of his leakproof diaper material for use in inkjet recording.

New claims 39 and 40 further differentiate from Morita et al. These claims have been amended to recite that the void initiator is present in an amount of 30 to 50 percent by volume of the feedstock for the microvoided layer, and the microvoided layer is the product of stretching in the longitudinal and transverse directions at a draw ratio in the range of 2 to 5 times such that the area ratio between the non-stretched and the biaxially stretched film is in the range of 9 to 20 times. Support for this amendment is to be found on page 12, lines 22 to 25, and page 11, line 22 to 24.

As previously mentioned in Applicants' last response, the only Example of biaxial stretching in Morita et al. (Example 3 in Table 3) used an amount of inorganic filler of about 33% (50 divided by 150), which in terms of volume is less than 20 percent (the density of the initiator is several times that of the polymer). In contrast, Applicants have used such inorganic filler in the

examples in an amount above 60 weight percent, approximately twice the inorganic loadings of Morita's Example 3, the sole example of biaxial stretching in Morita et al. (The organic void initiators, having a lower density, can be used at lower weight percents.)

Applicants submit that the materials made by Morita et al. would not be useful in an inkjet recording element because it would not allow the necessary passage of the liquid ink through the material. On the other hand, changing the composition of Morita et al. to meet the limitations of the present invention is likely to be inconsistent with Morita's purpose of obtaining a leakproof material. See, for example, page 2, lines 51 to 54, of Morita et al which states that "the film is useful as a material for leakproof films of sanitary materials such as a paper diaper and packaging materials." The burden is on the Examiner to demonstrate that a diaper is obviously an inkjet recording element.

In view thereof, it follows that the subject matter of the claims would not have been obvious in view of Morita et al. at the time the invention was made.

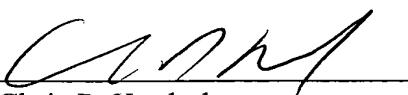
Applicants have reviewed the prior art made of record and believe that singly or in any suitable combination, they do not render Applicants' claimed invention unpatentable.

In view of the foregoing remarks and amendment, the claims are now believed allowable and such favorable action is courteously solicited.

Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

Respectfully submitted,

CPK:clb  
Rochester, NY 14650  
Telephone: (585) 722-0452  
Facsimile: (585) 477-1148

  
Chris P. Konkol.  
Attorney for Applicant(s)  
Registration No. 30,721